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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KYLE, MICHAEL J

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,651

Applicant(s)

ROLLINS ET AL.

Examiner

Michael J Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-29, are rejected under 35

U.S.C. 102(e) as being anticipated by Markus (U.S. Patent No. 6,499,042).

3. With respect to claims 1, 2, 4, 6, 15, 16, 18, and 20, Markus discloses a method for processing requests from a client (web browser 13) for electronic documents (17) located at a server (document server 15), comprising the steps of receiving, by an intermediary (selective proxy 14) disposed between the client (document browser) and server (document server, see figure 1) a request (column 3, lines 29-31) from the client for an electronic document located at a first address at the server. The request is made by a user (external entity) at the client. The intermediary (14) retrieves the electronic document from the first address (on document server 15, column 3, lines 36-38) and information associated with the user (in task 26). An updated electronic document is generated (by filling in blank fields) from the retrieved electronic document that includes at least a portion of the information associated with the user. The updated electronic document is provided to the client (13) in response to the request (column 3, lines 42-43). Additionally, Markus discloses receiving validation data from the user and validating the validation data (column 3, lines 30-32). The information associated with the user

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is stored via an Internet cookie (Abstract). The electronic document is a web page, and the updated electronic document is a web page generated by an integrated order mechanism.

4. With respect to claims 8-10 and 22-24, Markus discloses the information associated with the user to be retrieved via a post from a server. The examiner considers the contacting of the Selective Proxy to be a post from a server. Markus also discloses the request from the user to be received at an intermediary (14), wherein the electronic document is stored on a server (document server 15), wherein the retrieving the electronic document comprises the steps of sending a new request from the intermediary (14) to the server (15, column 3, lines 36-38), and receiving at the intermediary, the electronic document from the server. Markus also discloses the information associated with a user to be retrieved from a wallet server. The user information in Markus is retrieved from the selective proxy. Because the selective proxy contains personal information, the examiner considers it a wallet server.

5. With respect to claims 12-14 and 26-28, Markus discloses the step of generating the electronic document to comprise generating the updated electronic document by updating one or more data fields based upon information associated with the user. Markus also determines whether one or more variables included in the electronic document include valid user data and revises the electronic document by substituting one or more data values from the user information. Examiner asserts that a blank field is not valid user data. Markus fills blank fields with valid user data. Furthermore, Markus determines whether one or more variables in the electronic document correspond to at least one of a plurality of data values, when one or more variable does not correspond, Markus examines the context in which each of the variables is

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used, identifies a particular data value from the plurality of data values, and substitutes the particular data value.

6. With respect to claim 29, Markus discloses a method for processing requests from a client (13) for electronic documents located at a server (15) comprising an intermediary (selective proxy 14), and a server that is associated with an electronic document (document server 15) located at a first address at the server, wherein the intermediary (14, column 3, lines 36-38), in response to a request from the client made by a user (external entity) at the client, retrieves the electronic document (17) from the first address and information associated with the user and generates an updated electronic document from the retrieved electronic document (by filling in blank fields) including at least a portion of the information associated with the user.

7. With respect to claims 30 and 31, the intermediary (14) is neither the client (13) nor the server (15).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Markus et al (U.S. Patent No. 6,490,601). From hereon, Markus (US 6,499,042) will be referred to as Markus '042, and Markus et al (US 6,490,601) will be referred to as Markus

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'601. While Markus '042 suggests that storing information associated with the user may be used with one or more other electronic documents, it is not specifically disclosed.

10. Markus '601 teaches that stored user information may be used with one or more other electronic documents. This allows the user information to be automatically filled in forms from a plurality of websites that are affiliate members of the service (column 7, line 63 – column 8, line 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus '042 so that the user information may be used with one or more other electronic documents, so that the user only has to register information at one central location.

11. Claims 5, 11, 19, 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Wong et al (U.S. Patent No. 5,956,699). Markus discloses personal information to be stored in a cookie. Because this cookie stores personal information, the examiner considers it a wallet cookie. However, Markus fails to disclose the information to be stored in an encrypted format.

12. Wong et al teaches a secure system for transactions where the user may encrypt their personal information that is stored on a server so as to limit access to their personal information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the stored user information of Markus as taught by Wong et al, so as to limit, and prevent access to the user's personal information.

13. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Rhoads (U.S. Patent No. 6,285,776). Markus fails to disclose the user information to be retrieved via the use of a tracer image.

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14. Rhoads teaches the use of a tracer image to identify a specific article can be identified through use of a detecting apparatus. This makes identifying marks difficult for unauthorized persons to recognize without proper equipment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus by including a tracer image to identify a user, and retrieve the associated user information, so as to provide discrete way of identifying the user.

Response to Arguments

15. Applicant's arguments filed January 5, 2004 have been fully considered but they are not persuasive. Examiner has used the same references in the rejections in this Office Action that were used in the first Office Action (mailed on October 3, 2003). However, because of the added limitations in the claims, clarifying the user, client, intermediary, and server, the examiner now considers the external entity, document browser 13, selective proxy 14, and document 15, of Markus '042 to be equivalent to the user, client, intermediary, and server, respectively, as presently claimed by applicant.

16. Applicant argues that Markus '042 does not disclose at least the feature of an intermediary disposed between the client and server for retrieving a requested electronic document. Examiner considers document browser 13, selective proxy 14, and document server 15 of Markus '042 to be equivalent to the client, intermediary, and server, respectively, as claimed by applicant. Examiner references figure 1 of Markus '042 to show the intermediary (proxy server 14) disposed between the client (document browser 13) and server (document server 15). Additionally, Markus '042 states that, "A Selective Proxy is piece of software that

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sits between a Document Browser and a Document Server in order to forward requests and responses generated by these modules” (column 2, lines 27-30). Markus ‘042 further discloses the functioning of the Selective Proxy in column 3, lines 36-44, where Markus ‘042 states, “the Selective Proxy contacts the same Document Server and the Document Browser connected in 17 and requests the exact same document”. The passage continues to explain that the fields of the document are filled with relevant information and “is then sent back to the Document Browser in 27 and displayed to the external entity”. These passages clearly recite an intermediary (selective proxy) disposed between the client (13) and server (15) for retrieving a requested electronic document.

17. Applicant argues that dependent claims 2-14 and 16-28 are patentable based on deficiencies of Markus with respect to claims 1, 15, and 29. The argued deficiencies of Markus ‘042 are addressed above in paragraph 16.

Conclusion

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 703-305-3614. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


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